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SEP 21 2004

In re Application of :
Gerber :
Application No. 10/822,412 :
Filed: April 12, 2004 :
Attorney Docket No. 17764-01 :
For: METHOD AND APPARATUS FOR :
CENTERING A GLASS FLOW CONTROL TUBE

OFFICE OF PETITIONS

ON PETITION

This is a decision on the petition filed August 9, 2004 (certificate of mailing date August 5, 2004), requesting, in effect, withdrawal of a Notice mailed July 30, 2004. The petition will be treated under 37 CFR 1.82.

The application was filed on April 12, 2004. However, on July 30, 2004, The Office of Initial Patent Examination mailed a "Notice of Omitted Item(s) in a Nonprovisional Application" (Notice) stating that the application had been accorded a filing date of April 12, 2004, and advising applicant that figures 3A, 4, and 5 described in the specification appeared to have been omitted.

In response, the present petition was filed. Petitioner has provided replacement sheets of the drawings missing and states that the drawings should be included with the papers filed on April 12, 2004 because they were originally filed in prior application No. 10/161,231, the entire disclosure of which was incorporated by reference into the present application at the time of its filing.

The petition is dismissed.

The mailing of a "Notice of Omitted Items" permits the applicant to either: (1) promptly establish prior receipt in the PTO of the items at issue (generally by way of a date-stamped postcard receipt (MPEP 503)), or (2) promptly submit the omitted items in a nonprovisional application and accept the date of such submission as the application filing date. An applicant asserting that the missing items were in fact deposited in the PTO with the application papers must file a petition (and the appropriate petition fee) with evidence of such deposit. An applicant desiring to submit the omitted items in a nonprovisional application and accept the date of such submission as the application filing date must file any omitted items with an oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such items and a petition under 37 CFR 1.182 (with the petition fee under 37 CFR 1.17(h)) requesting the later filing date within two months of the date of the "Notice of Omitted Items" (37 CFR 1.181(f)).

In this case, petitioner neither asserts that the missing drawings were actually deposited in the PTO on April 12, 2004 with the other application papers nor requests a later filing date.

Instead, applicant seeks to add the figures to the present application as replacement figures on the basis that they are not new matter. However, no petition is necessary for that purpose. Additional

figures may be entered by the primary examiner without a petition so long as the pages contain no new matter. See MPEP § 608.02(a).

MPEP 201.06(c) states that:

... an applicant may incorporate by reference the prior application by including, in the application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuing application to include any subject matter in such prior application(s), without the need for a petition. (emphasis supplied)

If applicants desire that figures 3A, 4, and 5 be added to the application, the appropriate procedure is by way of amendment requesting the entry of the figures. Any such amendment should be filed prior to the first action on the merits and will be considered by the primary examiner.

Accordingly, the petition is inappropriate and is subject to dismissal. A \$130.00 Petition to Commissioner fee will be charged to deposit account no. 50-0852.

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of April 12, 2004. Replacement figures 3A, 4, and 5 will not be processed at this time.

Thereafter, the application will be forwarded to Technology Center 1700 for examination in due course.

Telephone inquiries specific to this matter should be directed to the undersigned at (703) 308-6712.



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for Patent Examination Policy